

### **REMARKS/ARGUMENTS**

The office action of February 24, 2005, has been carefully reviewed and these remarks are responsive thereto. Claims 4, 12, 20, 24, 28, 30-32, 46-47, 50, 60, 63, 71, and 75 have been amended to clarify the scope of protection. Claim 27, 42-45, and 79-82 has been canceled without prejudice or disclaimer. Claim 83 has been added. Claims 1-26, 28-41, 46-78, and 83 remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

#### ***Claims 46-50 and 56-59***

Claims 46-50 and 56-59 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Howard *et al.* (U.S. Pat. No. 6,353,886, hereinafter *Howard*). Applicant respectfully traverses the rejection.

Applicant's amended independent claim 46 recites, among other features, a virtual private network (VPN) device comprising "a memory containing a certificate that has been signed by a certification authority...and a processor programmed to receive a request for establishing a VPN between the VPN device and a second VPN device." The Action relies on Figures 3 and 4 of *Howard* as anticipating these features of Applicant's claim 46. Specifically, the Action relies on the policy database 32 as shown in Figures 3 and 4 of *Howard*. However, as shown in the Figures of *Howard*, a VPN is not established between the policy database 32 and another device. Figure 4 of *Howard* describes how the policy database 32 is accessed by a resource, such as network resource 74, to retrieve an attribute certificate to be used to establish a communication path between the resource and another resource. *Howard* fails to teach or suggest a VPN device including, "a memory containing a certificate that has been signed by a certification authority...and a processor programmed to receive a request for establishing a VPN between the VPN device and a second VPN device," as recited, among other features, in Applicant's claim 46. Because *Howard* fails to teach or suggest every feature of Applicant's claim 46, withdrawal of the present rejection is respectfully requested.

Claims 47-50 and 56-59 are allowable for all the reasons given above concerning their respective base claims, and further in view of the novel features recited therein.

***Claims 1, 4-7, 13-16, 21-23, 60, 63-65, and 72-74***

Claims 1, 4-7, 13-16, 21-23, 60, 63-65, and 72-74 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Genty *et al.* (U.S. Pat. No. 6,675,225, hereinafter *Genty*). Applicant respectfully traverses the rejection.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, the prior art did not discover or appreciate the problem that is solved by the invention. Thus, there cannot be any expectation of success or any reason to modify the reference when one does not know that some modification or combination will solve a problem that the individual does not know even exists. The Office Action states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to “exchange the assigned certificates between the first VPN device and the second VPN device in order to positively authenticate either end of the communication link before data is transferred.” This is not a proper motivation, however, but rather is the conclusion the examiner has apparently reached after having benefited from reading Applicant’s own disclosure, and is thus impermissible hindsight.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicant respectfully submits that that there is no motivation or suggestion to modify *Genty* as so stated.

Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office

Action provides no evidence that the modification takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office Action provide any evidence that the modification does not include knowledge gleaned only from Applicant's disclosure. Specifically, the background section of Applicant's written description describes one problem sought to be solved by the present invention. Specifically, page 5, lines 5 to 7 of Applicant's original written description states, "[b]ecause specific parameters about a destination LAN that will be connected through the VPN are required, merely trusting the 'other side' to provide the required parameters could result in an invalid range of IP addresses being provided to a site." This is the same problem that is not addressed in *Genty*. Thus, the modification is an improper modification based on hindsight.

Still further, the cited portion of *Genty* merely describes a conventional distributed data processing type system. (Col. 3, lines 27-29 and col. 6, lines 35-51). Later portions of *Genty* describe using IP-address-evading snoop avoiders 516 and 518 in gateways 510 and 512 to switch between multiple VPN tunnels in a conventional distributed data processing type system. (Col. 6, lines 62-67). *Genty* states that, "[d]igital certificates may also be used to positively authenticate either end of the communication link before data is transferred." (Col. 6, lines 49-51). However, *Genty* fails to teach or suggest any manner outside of the conventional manner for authentication. As described in Applicant's original specification, "[f]or the distributed management approach, each site independently requests a certificate from a certification authority for each VPN device that is controlled by the requesting site." (Applicant's original written description, page 2, lines 4-6). As such, *Genty* fails to teach or suggest every feature of Applicant's independent claim 1, and Applicant's respectfully request withdrawal of the present rejection..

Claim 60 includes many of the same features as described above with reference to claim 1. Thus, for at least the same reasons, Applicant's independent claim 60 is patentably distinguishable over the art of record.

Claims 4-7 and 13-15, as well as claims 63-65 and 72-74, which depend from claims 1 and 60 respectively, are allowable for all the reasons given above concerning their respective base claims and further in view of the novel features recited therein. For example, with respect

to Applicant's claim 7, the Action cites nothing in support of the feature of, "wherein the source/destination designation includes a wild card designation." In response, the Action admits, "Genty fails to disclose the destination designation includes a wild card designation." (Action, page 5). The Action states,

"However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to designate the wild card destination just in case the designated receiver or destination is unable to receive the data at present time and forwarding the received data to its intended destination when available to receive the data – thus minimizing the network resources by releasing the connection once the data has been delivered to the wild card designation or the intended destination." (Action, pages 5-6).

Again, this is not a proper motivation, however, but rather is the conclusion the examiner has apparently reached after having benefited from reading Applicant's own disclosure, and is thus impermissible hindsight. There is nothing noted in the *Genty* reference to conclude such a motivation. "Minimizing the network resources" is not a goal of the *Genty* system. The *Genty* system is concerned with preventing eaves-dropping snoops from obtaining data being transmitted in a VPN. There is nothing in *Genty* to glean such a motivation as stated in the Action. As such, Applicant's claim 7 is not taught or suggested in *Genty*.

To the extent independent claim 16 has the same or similar features as independent claims 1 and 60 discussed above, the reasons differentiating those claims from *Genty* apply to claim 16 as well. Accordingly, claim 16 is patentably distinguishable from *Genty*.

Claims 21-23, which depend from claim 16, are allowable for all the reasons given above concerning their respective base claims and further in view of the novel features recited therein.

***Claims 2-3, 8-12, and 17-20***

Claims 2-3, 8-12, and 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Genty* in view of *Howard*. Applicant respectfully traverses the rejection.

Dependent claims 2-3, 8-12, and 17-20, which depend from claims 1 and 16 respectively, are patentably distinct over the art of record at least for the same reasons as their base claims and further in view of the novel features recited therein. For example, with respect to Applicant's claim 8, the Action is silent with how *Genty*, either alone or in combination with *Howard*,

teaches or suggests, “a step of verifying at the first VPN device the second signed certificate having at least one verified VPN parameter for the second VPN device.” Applicant submits that neither *Genty* nor *Howard*, either alone or in combination, teaches or suggests at least this feature of Applicant’s claim 8.

***Claims 24-33, 36-39, 41, 46, and 75-78***

Claims 24-33, 36-39, 41, 46, and 75-78 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Genty* in view of *Muniyappa et al.* (U.S. Pat. No. 6,092,200, hereinafter *Muniyappa*). Applicant respectfully traverses the rejection.

The prior art did not discover or appreciate the problem that is solved by the invention. Thus, there cannot be any expectation of success or any reason to modify the reference when one does not know that some modification or combination will solve a problem that the individual does not know even exists. The Office Action states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to “provide the teaching of *Muniyappa* in the system taught by *Genty* in order to provide a secure communication tunnel over the public network thus the first VPN device and the second VPN device can positively authenticate either end of the communication link before data is transferred..” (Action, Page 10). This is not a proper motivation, however, but rather is the conclusion the examiner has apparently reached after having benefited from reading Applicant’s own disclosure, and is thus impermissible hindsight. This statement provides no motivation in either reference to combine the two. Thus, Applicant respectfully submits that that there is no motivation or suggestion to modify *Genty* as so stated.

Even assuming without admitting that the combination of *Genty* and *Muniyappa* is proper, the combination of references fails to teach or suggest every feature of Applicant’s claim 24. The features of canceled dependent claim 27 have been incorporated into amended independent claims 24 and 75. Amended independent claims 24 and 75 each recites, among other features, “exchanging the signed certificate with another VPN device at a selected telecommunications network address.” The Action cites no portion of *Genty* or *Muniyappa* as teaching or suggesting this feature. As recited in column 5, lines 53-57 of *Muniyappa*, [e]ach

node queries the certification authority to receive the public key by providing the certification authority with the master's address information so that the certification authority can look-up the appropriate public key for the master based upon its address information." As stated above with respect to Applicant's claim 1 and 60, *Genty* fails to teach or suggest any manner outside of the conventional manner for authentication. As described in Applicant's original specification, "[f]or the distributed management approach, each site independently requests a certificate from a certification authority for each VPN device that is controlled by the requesting site." (Applicant's original written description, page 2, lines 4-6). *Muniyappa* fails to cure the deficiencies of *Genty* to teach or suggest, "exchanging the signed certificate with another VPN device at a selected telecommunications network address." Accordingly, amended independent claim 24 is patentably distinct from the art of record and withdrawal of the rejection is respectfully requested.

Claim 75 includes many of the same features as described above with reference to claim 24. Thus, for at least the same reasons, Applicant's independent claim 75 is patentably distinct over the art of record.

Claims 25-33, 36-39, and 41 and 76-78, which depend from claims 24 and 75 respectively, are allowable for all the reasons given above concerning their respective base claims, and further in view of the novel features recited therein.

With respect to Applicant's claim 46, the Action, on page 13 appears to include language and terms not found in the claim. Applicant believes this entry addressing claim 46 is an error in light of the fact that claim 46 is already addressed with respect to the *Howard* reference. With respect to the *Genty* and *Muniyappa* references, Applicant respectfully requests clarification of this rejection if the Action did intend it.

#### ***Claims 34-35, 40, and 51-55***

Claims 34-35, 40, and 51-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Genty* in view of *Muniyappa* and further in view of *Howard*. Applicant respectfully traverses the rejection.

Dependent claims 34-35, 40, and 51-55, which depend from claims 24 and 46 respectively, are patentably distinct over the art of record at least for the same reasons as their base claims and further in view of the novel features recited therein. For example, with respect to Applicant's claim 54, the Action cites nothing in support of the feature of, "wherein the source/destination designation includes a wild card designation." In response, the Action admits that the combination of three references, "Genty-Muniyappa-Howard fails to disclose the destination designation includes a wild card designation." (Action, page 17). The Action applies the same reasoning as described above with respect to Applicant's claim 7. For at least the same reasons as stated above with respect to Applicant's claim 7, Applicant's claim 54 is not taught or suggested in the combination of *Genty-Muniyappa-Howard*.

#### ***Claims 61-62 and 64-71***

Claims 61-62 and 64-71 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Genty* in view of *Howard*. Applicant respectfully traverses the rejection.

Dependent claims 61-62 and 64-71, which depend from claim 60, are patentably distinct over the art of record at least for the same reasons as their base claims and further in view of the novel features recited therein. For example, with respect to Applicant's claim 67, the Action is silent with how *Genty*, either alone or in combination with *Howard*, teaches or suggests, "a step of verifying at the first VPN device the second signed certificate having at least one verified VPN parameter for the second VPN device." Applicant submits that neither *Genty* nor *Howard*, either alone or in combination, teaches or suggests at least this feature of Applicant's claim 67.

#### ***New Claims***

Applicant has added new claim 83, supported by the specification as filed. No new matter has been added.

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### **CONCLUSION**

All rejections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3155.

Respectfully submitted,  
**BANNER & WITCOFF, LTD.**

Dated this 24th day of May, 2005

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